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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,429	08/02/2001	Lars Morch Groth	NN-6200.200 US	3993

23650 7590 02/24/2005  
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PATENT DEPARTMENT  
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EXAMINER

PICKETT, JOHN G

ART UNIT PAPER NUMBER

3728

DATE MAILED: 02/24/2005

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**MAILED**  
**FEB 24 2005**  
**GROUP 3700**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/921,429  
Filing Date: August 02, 2001  
Appellant(s): GROTH, LARS MORCH

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Marc A. Began  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 26 January 2005.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on 25 January 2005 places the application in better form for appeal and has been entered.

**(5) *Summary of Claimed Subject Matter***

The summary of invention contained in the brief is correct.

**(6) *Grounds of Rejection to be Reviewed on Appeal***

The appellant's statement of the issues in the brief is correct.

**(7) Grouping of Claims**

Appellant's brief includes a statement that claims 19, 21, and 22 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

5,873,642	Nguyen et al.	02-1999
4,203,518	Current, Wayne A.	05-1980

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen et al. (US 5,873,462) in view of Current (US 4,203,518). This rejection is set forth in a prior Office Action, mailed on 29 July 2004.

**(11) Response to Argument**

Examiner's response to the appellant's arguments concerning claim 19:

Appellant initially asserts that in the magazine of NGUYEN et al "...only the pen can be rotated by the user." The examiner disputes this premise and notes that

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NGUYEN et al is a portable device (Column 3, lines 9-12). NGUYEN et al carries "pen needle assemblies" which are of the size to approximate the end of a "pen" (see Figure 1), which places the device on the hand-held scale. Nothing in NGUYEN et al prevents the entire device from rotation as well as the pen during manual use. Further, the appellant admits that the design of NGUYEN et al lends itself to being placed in the palm of the hand (see page 16, lines 6-9 of the appeal brief).

Appellant argues that the claimed configuration provides "unexpected advantages".

Any differences between the claimed invention and the prior art may be expected to result in some differences in properties. The issue is whether the properties differ to such an extent that the difference is really unexpected. *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986), MPEP § 716.02. Appellant's mode of connection is a rotational delivery with equidistant forces causing rotation about a point. This principle is taught in Statics to first year mechanical engineering students and is termed a "force couple". The examiner contends that the appellant's device performs precisely as would be expected from a "force couple". Further, "[a] greater than expected result is an evidentiary factor pertinent to the legal conclusion of obviousness ... of the claims at issue." *In re Corkill*, 711 F.2d 1496, 226 USPQ 1005 (Fed. Cir. 1985). The evidence relied [upon] should establish "that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance." *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992) (Mere conclusions in

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appellants' brief that the claimed polymer had an unexpectedly increased impact strength "are not entitled to the weight of conclusions accompanying the evidence, either in the specification or in a declaration.") See MPEP §§ 716.02(a) and 716.02(b). The examiner asserts that the appellant has failed to provide the necessary evidence of unexpected results in the specification as originally filed and notes that no declarations under 37 C.F.R. 1.132 have been submitted by the appellant.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation can be found in the knowledge that was generally available to one of ordinary skill in the art at the time the invention was made, where it was a well established principal of design for portable objects to limit overall size. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

In response to the appellant's arguments that *In re Japikse* is not relevant to this case, the examiner asserts that the cavities for receiving the pen needle, the means for

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preventing needle rotation, the means for preventing cover rotation, and the sterility barrier of NGUYEN et al all perform the same functions whether pen insertion is radial or perpendicular.

Appellant argues that NGUYEN et al both explicitly and implicitly teaches away from the claimed invention.

To teach away, either explicitly or implicitly, the prior art must disclose or imply that the claimed invention was undesirable, or that known disadvantages in the prior art would naturally discourage search for new inventions. Except for the figures, NGUYEN et al is silent on orientation of the needle cavities. While these figures suggest a preferred orientation, it is not seen how this preference, either explicitly or implicitly, would lead one of ordinary skill in the art to believe that radial cavities would be undesirable, unacceptable or inoperable.

Appellant argues that CURRENT fails to teach, either explicitly or implicitly, a reduced height.

When the reference is a utility patent, it does not matter that the feature shown is unintended or unexplained in the specification. The drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art. *In re Aslanian*, 590 F.2d 911, 200 USPQ 500 (CCPA 1979).

In response to appellant's argument that CURRENT is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or,

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if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, CURRENT is considered pertinent to the compact storage of a needle magazine.

Examiner's response to the appellant's arguments concerning claim 21:

As set forth in the final rejection of 29 July 2004, the examiner has presented the case that NGUYEN et al inherently discloses grasping in the hand, and explicitly discloses screw connection (Column 5, lines 36-38). The assertion is of inherent rotation of the injection device and the magazine. The examiner asserts that the degree of rotation is dependent on the depths of the threads used for connection of the needle with the injection device, with the specific degree of rotation being an obvious matter of design choice.

Examiner's response to the appellant's arguments concerning claim 22:

The appellant argues that claim 22 incorporates the same inventive features set forth in claim 19 and that the arguments presented for claim 19 apply to claim 22. As such, the examiner will rely on the arguments against claim 19 presented above.

For the above reasons, it is believed that the rejections should be sustained.



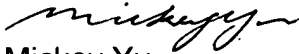
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Respectfully submitted,



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February 14, 2005

Conferees



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